REMARKS

Claims 1-33 are pending. Claims 18-28 are withdrawn. Claims 1-17 and 29-33 are presented for examination.

The Applicants prefer to advance prosecution before making a determination of which claims, if any, to cancel.

The Applicants have noted AU 3695 as the Examiner's new art unit.

Finality of the Rejection

The Applicants submit that the final rejection by the Office is premature.[1] In the non-final office action issued March 18, 2008, the Examiner did not make any prior art rejections to the Applicants' claims and thus, failed to give the Applicants a fair opportunity to reply to any perceived issues. The amendments made by the Applicants in their previous response addressed §101 rejections but did not change the substantive subject matter claimed. Since the Examiner has introduced new grounds of rejections that were not necessitated by the Applicants' previous amendments, the currently pending action should properly be made non-final.

Accordingly, the Applicants request withdrawal of the finality of this action.

35 U.S.C. § 112

The Examiner rejected claims 1-17 as directed towards unpatentable subject matter under 35 U.S.C. 112, first paragraph asserting that the claims "**are drawn to a system with single means**."[2]

The Applicants disagree. A single means claim is a claim "where a means recitation does not appear in combination with another recited element of means[.]"[3] The MPEP specifies that "a claim element that does not include the phrase 'means for' or 'step for' will not be considered

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[1] According to the MPEP 706.07(a), second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement.
[2] *See* Office Action dated December 26, 2008 at Page 2.
[3] See MPEP 2164.08(a).

to invoke 35 U.S.C. 112, sixth paragraph."[4] Thus, the claim, as previously presented, did not invoke means-plus-function under 35 U.S.C. § 112 since the claim does not recite any "means for" language. Moreover, even if "a client station for entering an order" were properly construed as a mean-plus-function recitation, which it is not, the client station is specified to include a display and a graphical user interface. Thus, there is no basis for the Examiner's conclusion that claims 1-17 are drawn to a single means. Accordingly, the Applicants request that the Examiner withdraw the rejection of claims 1-17 under 35 U.S.C. 112, first paragraph.

The Examiner rejected claim 2 under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. Claim 2 recites "a server system that receives the order from the client system."

The Examiner argues:

> It is not clear how the client station in claim 1 is related/connected/linked to the server system of claim 2. The elements relating the two structural elements are missing in claim 2. Hence the scope of the claim is not clear to one of ordinary skill in the art. A claim is considered indefinite if it does not apprise those skilled in the art of its scope. Appropriate correction is required.[5]

The Examiner is incorrect. Claim 2 defines the connection between the two structural elements by stating that "a server system … receives the order from the client system."[6] Moreover, the cases cited in MPEP 2172.01 are quoted as specifying that "a claim does not necessarily fail to comply with 35 U.S.C. 112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes."[7] Thus, there is no requirement to further specify how the elements are "related/connected/linked."

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[4] See MPEP 2181(I).
[5] See Id. at Page 3.
[6] According to the MPEP, "if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph … but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant."
[7] See MPEP 2172.01 quoting Ex parte Huber, 148 USPQ 447, 448-49 (Bd. Pat. App. 1965).

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The Examiner further rejected claims 1-17 and 29-33 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Examiner argues:

> **Independent claim 1 recites the limitation "that allows the user to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue". It is not clear as to what is the outcome of using this feature. Allowing a user to perform a function does not necessarily imply that the function is performed.** [8]

Claim 1, as amended, positively recites "a display, and a graphical user interface rendered on the display, the graphical user interface allowing the user to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue." It is clear according to the Applicants' recited claim language that the "the graphical user interface" allows a user to choose a priority type.

The Examiner also argues:

> **Independent claims 1 and 29 also recite the limitations "that can at least in part satisfy the order" and "how the order interacts with contra side quotes/orders in the trading venue". It is not clear what the applicants mean by these limitations. Specifically the metes and bounds of the limitations "satisfy the order" and "how the order interacts" are unclear. Hence the scope of the claim is not clear. Dependent claims are rejected by way of dependency on a rejected independent claim. Appropriate correction is required.** [9]

The Applicants disagree. Under 35 U.S.C. §112, the applicable test is whether the claims define the patentable subject matter with a reasonable degree of particularity and distinctness.[10] The Applicants' present claims recite features that are part of a system for trading of securities. While the Examiner concludes that the metes and bounds of these limitations are unclear, the Examiner reaches this conclusion without meeting his burden of establishing why the phrases used in the claims 1 and 29 are "vague and indefinite."[11] The Applicants contend that one of

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[8] *See* Office Action at Page 3.
[9] *See* Office Action at Pages 3-4.
[10] *See* MPEP 2173.02
[11] Id.

skill in the art could consult the specification if, in fact, such person could not understand the recited limitations, without importing limitations from the specification into the claims.[12]

The Examiner further argues:

> **Also dependent claims 2-17 and 30-33 recite limitations such as "the non-directed order", "marketable limit order", "Liability Order", "priority that is strict price/time, or price/size/time, or price/time", "non-attributable agency orders of UTP Exchanges", "principal quotes of UTP Exchanges", "separate quote-access fee", "separate quote- access fee to non-subscribers" which are not clear. Appropriate correction is required for all these claims.** [13]

The Applicants responded to the previous Office Action by pointing out that - (1) the portions cited by the Examiner refer to common terms of art that are well known within the field of electronic trading venues and (2) a person of ordinary skill in the art would be able to determine the scope of the claims, and, if need be, the person skilled in the art could consult the Applicant's specification and the recited claim language for additional guidance. In response, the Examiner notes that: **"Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims."**[14] The Applicants have not argued that the Examiner should import limitations from the specification. However, it is well recognized that the ordinary and customary meaning of a term may be evidenced by a variety of sources, including "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art."[15] A person of ordinary skill in the art at the time of the Applicants' invention would have been able clearly determine the metes and bounds of the pending claims based on the ordinary usage of the claim terms in the field, alone or with reference to the Applicants' specification.

For at least these reasons, the Applicants request that the rejection of claims 1-17 and 29-33 under 35 U.S.C. 112, second paragraph be withdrawn.

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[12] See MPEP 2173.05(a) ("the meaning of every term used in a claim should be apparent from the prior art or from the specification and drawings at the time the application is filed.").
[13] See Office Action at Pages 3-4.
[14] See Office Action at Page 6.
[15] See Phillips v. AWH Corp., 415 F.3d 1303, 1314 (Fed. Cir 2005). See also MPEP 2111.01(III).

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35 U.S.C. §103

The Examiner rejected claims 1-17 and 29-33 as being obvious over "NASD Rulemaking: Relating to an Integrated Order Delivery and Execution System" dated March 4, 1998 ("NASD").

However, NASD neither describes nor suggests "a display, and a graphical user interface rendered on the display, the graphical user interface allowing the user to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue," as recited in claim 1.

The Examiner argues:

> **Claims 1 and 29, Reference U discloses a system for an electronic venue for trading of securities and a computer program product for an electronic trading venue for trading of securities said computer program product residing on a computer readable medium comprising instructions for causing a computer to: receive an order entered from a client station the orders for execution against any participant that can at least in part satisfy the order (See the entire disclosure of Reference U especially pages 3, 9 and 3 1-38); and determine a priority type for how the order interacts with contra side quotes/orders in the trading venue (See the entire disclosure of Reference U especially pages 3,9 and 3 1-38). A computer program product for performing the above steps are inherent in the disclosure as is a client station including a graphical user interface for entering an order.** [16]

The Applicants disagree. While NASD describes that orders may be directed to a particular Nasdaq Market Maker, ECN, or UTP Exchange Specialist for execution, NASD is silent as to allowing the user to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue.

This is not a trivial distinction. In one example from the Applicants' Specification, the selection of priority types can give "market participants a choice to determine how best to execute their customer or proprietary orders. This processing is an attempt to address best execution concerns while being flexible to meet participant's needs without imposing a needlessly rigid structure on the market." [17]

The Examiner also argues:

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[16] See Office Action at Pages 4-5.
[17] See Applicants' Specification at Page 2, line 24 – Page 3, line 6.

> **In the alternative, a system for trading of securities with a client computer station including a graphical user interface for entering an order and specifying the order parameters are old and well known in the electronic trading of securities. A system with a computer program product to perform the steps of ordering and specifying the order parameters are also old and well known. These features make the ordering process time and cost efficient compared to a manual process.** [18]

The Applicants disagree. Although not conceding that the Examiner's characterization of what was "old and well known" in the art is correct, the Applicants note that the Examiner's assertion does not correspond to the features of, for example, the Applicants' claim 1 which recites:

> **a client station for entering an order executable against any participant that can at least in part satisfy the order; the client station including:**
> **a display; and**
> **a graphical user interface rendered on the display, the graphical user interface allowing the user to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue.**

Thus, NASD does not describe or render obvious all of the features of claim 1. Claims 2-17 are dependent on claim 1 and are allowable for at least the same reasons.

Claim 29 includes instructions to "determine a priority type for how the order interacts with contra side quotes/orders in the trading venue," and is allowable for at least analogous reasons as those discussed with respect to claim 1. Claims 30-33 are dependent on claim 29 and are allowable for at least the same reasons.

The Applicants request that the rejections of claims 1-17 and 29-33 under 35 U.S.C. § 103 be withdrawn.

Conclusion

It is believed that all the rejections and/or objections raised by the Examiner have been addressed.

All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

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[18] *See* Office Action at Pages 4-5.

Any circumstance in which the Applicants have (a) addressed certain comments of the Examiner does not mean that the Applicants concede other comments of the Examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the Applicants concede any of the Examiner's positions with respect to that claim or other claims.

No fees are believed due at this time. Please apply any other charges or credits to deposit account 06-1050 referencing attorney docket 09857-0061001.

Respectfully submitted,

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